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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,555	08/09/2001	Amir H. Hoveyda	2846/1002	5529

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EXAMINER

CHOI, LING SIU

ART UNIT PAPER NUMBER

1713

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

Office Action Summary	Application No. 09/925,555	Applicant(s) HOVEYDA ET AL.	
	Examiner Ling-Siu Choi	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 September 2002 and 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 29-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) 9-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/09 and 11/09/ 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/22/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Preliminary Amendment filed November 9, 2001, the Preliminary Amendment (submitting changes to Figure 3) filed November 9, 2001, and the Preliminary Amendment filed September 23, 2002. Claims 1-48 are now pending. After a further consideration on the Restriction /Election requirement, the claims are rearranged to better reflect the distinct inventions.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-28, drawn to a transition metal catalyst , classified in class 502, subclass 125.
 - II. Claims 29-38, drawn to a transition metal catalyst having at least one substituent reacting with functional groups on the substrate and a supported transition metal catalyst, classified in class 502, subclass 167.
 - III. Claims 39-48, drawn to a method to immobilize the transition metal catalyst, classified in class 502, subclass 87.
3. The inventions are distinct, each from the other because of the following reasons:
- Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

Art Unit: 1713

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to a transition metal catalyst and a transition metal catalyst having at least one substituent reacting with functional groups on the substrate. It is noted that the transition metal catalyst being chemically bonded to the substrate. As a whole, the transition metal catalyst is different from the supported transition metal catalyst.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to a transition metal catalyst and a method to immobilize the transition metal catalyst.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process to polymerize a transition metal catalyst containing at least one vinyl substituent.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1713

5. During a telephone conversation with Ms Paula Campbell Evans on August 6, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless --

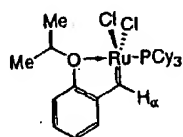
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by

Art Unit: 1713

Kingsbury et al. [J. Am. Chem. Soc., **121**, 791-799(1999)].

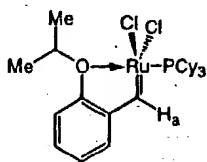
Kingsbury et al. disclose a recyclable Ru-based metathesis catalyst represented in the form of



Thus, the present claims are anticipated by the disclosure of Kingsbury et al..

9. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrity et al. [J. Am. Chem. Soc., **120**, 2343-2351(1998)].

Harrity et al. disclose a metal-containing catalyst to convert styrenyl ethers to 2-substituted chromenes, the metal-containing catalyst being represented in the general form of



Thus, the present claims are anticipated by the disclosure of Harrity et al..

Conclusion

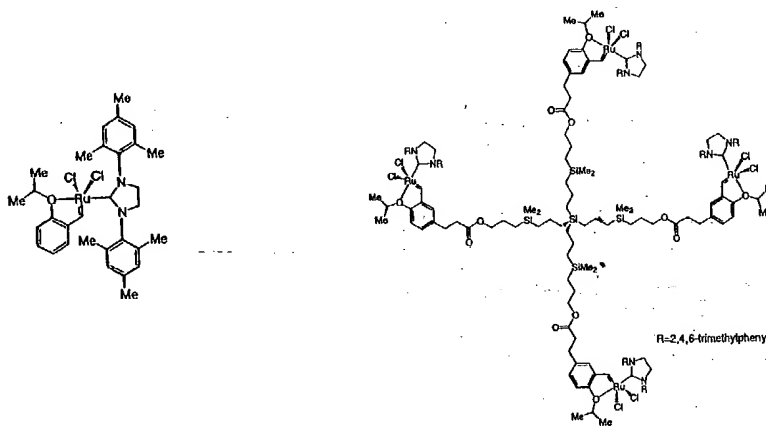
10. Claims 9-12 (the electron-donating heterocyclic carbene ligand being 4,5-dihydroimidazole-2-ylidene) and claims 13-28 (the transition metal catalyst being part of

Art Unit: 1713

a dendrimer compound) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Garber et al. [J. Am. Chem. Soc., **122**, 8168-8179(August 12, 2000)

Garber et al. disclose a Ru-based metathesis catalyst having the electron-donating heterocyclic carbene ligand being 4,5-dihydroimidazole-2-ylidene and being part of a dendrimer compound:



The publication date on web is August 12, 2000, later than the priority date of August 10, 2000.

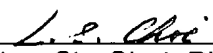
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-

Art Unit: 1713

1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.

September 15, 2004


Ling-Siu Choi, Ph.D.
Primary Examiner
Art unit: 1713